

REMARKS

Claims 1-4, 6-23, 25-42, 44-61, 63-89, 91-97 remain in connection with the present application, with claims 1, 20, 39, 57, 72 and 86 being independent. Claims 5, 24, 43, 62 and 90 have been canceled without prejudice or disclaimer of the subject matter contained therein.

Oath/Declaration

Applicants note the Examiner's comments that the Declaration does not identify the citizenship of each inventor. Specifically, the citizenship of each inventor is identified, except for that of inventor, Paul ANDRES. Mr. ANDRES is a citizen of Germany, as indicated by his German address. If an additional Declaration is needed, Applicants request that the Examiner indicate this, and a new Declaration will be filed in the near future.

Discussion of Exemplary Embodiment

The present application, in a preferred embodiment, is directed to a word prediction system which can predict both words and chunks of words. By making word chunks available for selection by a user, a user can more quickly move through word prediction. A word chunk is made available for selection by a user by use of an identifier, identifying it as a word chunk and/or differentiating it from other selectable words.

As one non-limiting example of such an identifier, a "tilde" symbol may be used such as that shown in Fig. 4a of the present application. As shown in the non-limiting example of Fig. 4a, upon entry of the letter z, the system predicts and displays three (3) word chunks including the aforementioned identifier, as well as three (3) words for selection by a user. Thereafter, as shown in Fig. 4b, if a word chunk including the identifier is selected, various other words beginning with the entire word chunk are displayed, including another word chunk which includes the first word chunk (noting that the word "zeitung" is identified as another word chunk with its identifier, and includes the previously selected word chunk "zeit").

Accordingly, by using such easily identifiable and selectable word chunks, one can predict lengthy words such as “zeitungsausschnitt” with only a short number of entries/selections (the letter z, the chunk zeit, and the chunk zeitung) as opposed to a letter by letter system which may not predict such a word until about 8 or more entries/selections (due to the fact that many words begin with the zeitung prefix).

Claim Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 1, 7-16, 18, 20, 26-35, 37, 39, 45-53 and 55 under 35 U.S.C. §102(a) as being anticipated by O'Dell. This rejection has been rendered moot in view of the incorporating of new subject matter of a claim not previously rejected into each of the independent claims. For example, claim 1 has been amended to incorporate the subject matter of claim 5; claim 20 has been amended to incorporate the subject matter of claim 24; claim 39 has been amended to incorporate the subject matter of claim 43; claim 57 has been amended to incorporate the subject matter of claim 62; claim 72 has been amended to incorporate at least a portion of the subject matter of claim 73; and claim 86 has been amended to incorporate at least a portion of the subject matter of claim 87. Accordingly, the rejection of various independent claims over the O'Dell reference has been rendered moot and thus withdrawal of this rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 2, 3, 5, 21, 22, 24, 40, 41 and 43 under 35 U.S.C. §103 as being unpatenable over O'Dell in view of Mickunas (U.S. Patent No. 5,040,113), the Mickunas '113 patent. This rejection is respectfully traversed.

Claim Amendments

Initially, claims 1 and 14 have been amended to correct a typographical error, correcting the word “work” to --word--. Such an amendment is a non-narrowing amendment which has not been made for any reason relating to patentability.

With regard to each of the independent claims of the present application, these claims have been amended to clarify that a word chunk includes a predetermined identifier, identifying it as a word chunk. As admitted by the Examiner, at least such a limitation is not taught or suggested by O'Dell.

Even if Combined, Alleged Reference Combination fails to meet all of the Limitations of the Independent Claims

As indicated above with regard to claim 1, and indeed with regard to each of the independent claims in connection with the present application, the O'Dell reference fails to teach or suggest at least the limitation of “**a word chunk...a word chunk includes a predetermined identifier, identifying it as a word chunk**”. As one non-limiting example of such a predetermined identifier, such an identifier maybe a “tilde” symbol such as that shown in Fig. 4a of the present application. By using such easily identifiable and selectable word chunks, a user can quickly and easily find word chunks and advance to desired words in a manner much quicker than known letter by letter word prediction systems. Although Applicants do not admit that the O'Dell reference meets other limitations of the various claims, including claim 1 for example, both Applicants and the Examiner agree that at least the aforementioned limitation of a word chunk including a predetermined identifier, identifying it as a word chunk, is a limitation which is not taught or suggested by O'Dell.

The Mickunas '113 Patent

The Mickunas '113 patent is directed to a method of manipulating data. The method relates to a method for programming a digital computer

for automatically collecting, storing, organizing and displaying data inputted by the operator. A character which is entered is stored as a first character variable "x", and such a character is used to identify a pre-stored list of phrases based on the character entered and based upon another variable "USERSTG". See column 3, lines 46-61 for example. Thereafter, a next character may be entered and is stored as the character "y", wherein the phrase stored in "USERSTG" is extended by appending the characters stored in "y". Thereafter, additional phrases including the lengthened variable "USERSTG" is displayed, wherein selections can be made therefrom. The prefix "USERSTG" can be distinguished from the remaining phrases in the selection list by underlining any other method. See column 4, lines 18-43 for example.

Alleged Combination of O'Dell and the Mikunas '113 Patent

As previously indicated, the Examiner admits that O'Dell does not teach or suggest a word chunk including a predetermined identifier, identifying it as a word chunk. The Examiner alleges that Mikunas teaches this limitation, citing column 4, lines 18-29, wherein it is indicated that the prefix "USERSTG" can be distinguished from the remainder of phrases in the select list (SL) by underlining or any other method suitable for presentation. The Examiner alleges that it would have been obvious for one of ordinary skill in the art to combine the teachings of O'Dell with the Mickunas '113 patent; and alleges that the motivation for doing so would have been to identify any prefix to the user which will have information concatenated upon in constructing a word (again citing column 4, lines 18-29 of the Mickunas '113 patent). Further, the Examiner takes official notice that would have been obvious to one of ordinary skill in the art to include as one of the possible predetermined identifiers as taught, including underlining in italics, to include a tilde as an identifier. Applicants respectfully traverse.

While Applicants do not necessarily dispute that an identifier may take many forms, including those other than a tilde, Applicants respectfully

submit that the alleged combined teachings of the O'Dell reference and the Mickunas '113 patent would still not meet the claimed limitation of a word chunk including a predetermined identifier, identifying it as a word chunk. Specifically, the Mickunas '113 patent is directed to **highlighting or underlining that which was entered**, namely the prefix "USERSTG", which may include the first entered character "x" and the second entered character "y" for example. This particular entered set of letters is taught as being distinguished from other phrases in the selection list (SL)-see column 4, lines 18-24 for example. However, this does not identify any selectable word chunk, as claimed, **it only identifies, at best, an input portion of selectable words.**

Thus, even if such a teaching could be combined with that of the O'Dell reference, which Applicants do not admit, such a teaching would still fail to makeup for the limitation as set forth in claim 1 for example, of a selectable word chunk, "wherein a word chunk includes a predetermined identifier, identifying it as a word chunk". As stated above, as claimed, a word chunk is something that is selectable, such as the chunk "zeit" shown in the non-limiting example of Fig. 4a of the present application. To the contrary, the "USERSTG" is clearly a prefix that includes, in a word prediction fashion, the first or first two letters of a word. Thus, when applied to the O'Dell patent, at best, **it would teach underlining of an entered letter such as "w" in the list of two letter combinations such as wh, we, wi; or the underlining of two entered letters such as wh for example, in a display of three letter groupings such as whi, whe, who.** Such an identifier merely attaching to what has been entered, is not the same as something which identifies a word chunk as a word chunk, instead of the selectable word for example. Accordingly, even assuming *arguendo* that the Mickunas '113 patent could be combined with the O'Dell reference, the teachings of the Mickunas '113 patent would still fail to teach or suggest anything with identifies a word chunk as a word chunk, instead of just a displayed selectable word for example.

Such a distinction is further clarified with reference to the non-limiting example of Fig. 4a. As shown in the exemplary format in Fig. 4a, the tilde identifies the selectable word chunks “zahn” and “zeit” as word chunks, differentiating them from selectable words such as “zeihen” and “zwischen”. At least such an identifier, which identifies a word chunk as a word chunk as claimed in claim 1 for example, and as somewhat similarly claimed in each of the independent claims, is not taught or suggested by the alleged combination of the O’Dell and the Mickunas ‘113 patent, even assuming *arguendo* that they could be combined.

Accordingly, for at least such reasons, Applicants respectfully submit that independent claim 1, and indeed each of the independent claims of the present application, is patentable over the alleged combination of O’Dell and the Mickunas ‘113 patent, even assuming *arguendo* that they could be combined. Thus, withdrawal of the rejection is respectfully requested.

Lack of Motivation to Combine Reference Teachings

The Examiner merely sets forth his opinion that it would have been obvious to combine the teachings of the O’Dell patent with those of the Mickunas ‘113 patent, alleging that it would have been obvious to identify any prefix to the user which will have information concatenated upon in constructing a word. The alleged motivation is not true for the reasons expressed above; and is further merely “opinion” set forth by the Examiner. As such, it **is not proper motivation** for combining the references. Thus, the Examiner has failed to establish a proper *prima facie* case of obviousness under 35 U.S.C. 103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill art, or in some cases, the nature of the problem to be solved. In re Dembicza, 50 USPQ2d 1614 (Fed.Cir. 1999). The statement made by

the Examiner have nothing to do with why someone would be lead to combine the letter by letter prediction system of O'Dell with the program system of the Mickunas '113 patent. The systems are completely distinct and have nothing to do with one another. The Examiner has not provided any reasons of the desirability of making the specific combination that was made by the applicant.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See Dembiczak 50 USPQ2d at 1617. Broad conclusory statements standing alone, such as those set forth by the Examiner, without evidentiary support in the references, are not "evidence". As such, they do not establish a prima facie case of obviousness under 35 U.S.C. §103(a).

In essence, the Examiner has used Applicants invention, in hindsight, as a blueprint. The Examiner's use of hindsight is clearly improper. The Examiner is not entitled to recognize deficiencies in prior art such as O'Dell, and then search only for the missing pieces of Applicants claim. There is no reason to highlight entered letters in a word prediction system such as in O'Dell. The Examiner must separately find evidence of reasons for making such a combination, independent of Applicants invention. The Examiner gives only "opinion", not evidence. Without this "evidence" of motivation, a prima facie case of obviousness under 35 U.S.C. §103(a) has not been established. Thus, the rejection is inapplicable and should not be maintained.

Further, relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. See *In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner must provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) and MPEP 2144.03(c). Accordingly,

Applicants respectfully challenge the Examiner's use of opinion or personal knowledge, and respectfully require the Examiner to withdraw the rejection or provide an Affidavit or Declaration as set forth above if the rejection is to be maintained. Accordingly, withdrawal of the rejection is requested.

Taking of Official Notice

Further, Applicants object to the Examiner's taking of official notice that it would have been obvious to one of ordinary skill in the art to include, as one of the possible predetermined identifiers, a tilde. While Applicants do not necessarily dispute that the term identifier as claimed in claim 1 could include things other than a tilde, such as underlining or italics, Applicants respectfully challenge the Examiner to find, in the prior art, the use of a tilde as an identifier in the context as claimed.

Additional Claim Rejections Under 35 U.S.C. §103

The Examiner has further rejected claims 4, 23 and 42 under 35 U.S.C. §103(a) as being unpatentable over O'Dell. In making this rejection, the Examiner again takes official notice. Applicants respectfully challenge the Examiner's taking of official notice indicating the use of word chunks, as claimed, in the German language.

Still further, Applicants respectfully traverse this rejection for reasons somewhat similar to those previously set forth, noting that independent claims have been amended to include additional subject matter which is admittedly not taught or suggested by O'Dell. Accordingly, withdrawal of the Examiner's rejection is respectfully requested.

The Examiner has further rejected claims 6, 17, 19, 25, 36, 38, 44, 54 and 56 under 35 U.S.C. §103 as being unpatentable over O'Dell in view of Kadashevich et al. (the Kadashevich et al. '577 patent). This rejection is respectfully traversed.

Again, Applicants note that the independent claims have been amended and thus, for reasons previously set forth in the corresponding independent claims, Applicants respectfully request that the rejection be

withdrawn. As previously stated, there are clearly deficiencies in O'Dell regarding the newly amended independent claims, deficiencies which are made up by the teachings or suggestions of the Kadashevich et al. patent, even assuming *arguendo* that they could be combined. Accordingly, withdrawal of the rejection is respectfully requested.

Further, regarding the alleged motivation for combining the references, Applicants respectfully suggest that proper motivation has not been provided and a *prima facie* case of obviousness has not been established. Thus, the combination of O'Dell and the Kadashevich et al. '577 patent is improper.

Finally, with regard to the remaining claims 59-97, these claims have not been specifically addressed. With regard to these remaining claims, these claims are allowable for at least reasons somewhat similar to those set forth above.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 1-4, 6-23, 25-42, 44-61, 63-89, 91-97 in connection with the present application is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants hereby petition for a two (2) month extension of time for filing a reply to the outstanding non-final Office Action and submit the required \$225.00 (small entity) extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Donald J. Daley at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37

C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY & PIERCE, P.L.C.

By _____


Donald J. Daley, Reg. No. 34,313

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/bof